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EXAMINER

AKERS, G

ART UNIT

2164

PAPER NUMBER

30

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/999,297

Applicant(s)

Pool et al.

Examiner

AKER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/21/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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DETAILED ACTION

Response to Amendment

1. The text of those sections of Title 35 US Code not included in this action can be found in a prior Office action(See Serial No: 08/999297). The text of those sections of Title 35 US Code not otherwise provided in a prior Office action will be included here where appropriate.
2. This action is responsive to the applicant's Request for Continued Examination(RCE) filed 6/11/01.
3. Claims 1,4-7,13 were amended. No claims were deleted. None were added.
4. Claims 1-17 are pending.

Claim Rejections - 35 USC § 112

5. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).
6. Applicant in the Abstract refers to electronic title and commercial invoice in the alternative- i.e. "Electronic title or commercial invoice." On page 27 of the Specification applicant equates electronic title with commercial invoice for purposes of carrying out the invention as originally disclosed.

(a) Abstract(line 7) "electronic title or commercial invoice"

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(b) Specification(page 27, lines 10-11): “electronic title(step 165) also referred to as commercial invoice”

In the affidavit of one of the inventors Mr. Edward Pool of 4/18/01(page 4, paragraph 12), Mr. Pool contradicts the Specification with respect to the electronic title and commercial invoice. Mr. Pool states that the “electronic title” INCLUDES the commercial invoice. This conclusion is at variance with the Specification as originally filed with respect to electronic title and commercial invoices. The Specification as originally filed equates electronic title with commercial invoice and does not state that the electronic title includes a commercial invoice. Thus, the Specification as originally filed states $A=B$. The applicant’s affidavit states B is contained in A ($B \subset A$). Thus applicant’s claim that states that the electronic title includes data from the commercial invoice is considered new matter.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Examiner rejects all claims under 35 USC 112(2nd paragraph) for the following reasons:
The specification equates the entities electronic invoice and commercial invoice. Applicant in claims 1 and 13 states that electronic title “includes at least the data content of a commercial invoice. The language would suggest that the commercial invoice is a subset of the electronic title

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and not its equal as the specification states. Thus this claim is ambiguous as to the metes and bounds of these terms.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-17 are rejected under 35 USC 103(a) as unpatentable over Schell and further in view of Cahn.

11. As per claim 1, Schell teaches a computerized process catalog management software selection system that employs electronic data interchange(EDI) to connect various functions in the business system of Schell(page 147;col. 2; lines 45-50). The system of Schell contemplates international transactions(page 147;col 4 lines 15-40) that includes a language selection or determination to process transactions; determining a currency(page 148;col 3 lines 15-20)(page 148; col 4; lines 25-35), and receiving a selection of products to be purchased and a destination for said products thereby triggering a calculation for all costs(bill to/ship to)(cols 3 & 4 of page 148). Schell also teaches automotive payment(page 4;col 4; lines 25-35) and the creation of an invoice(page 4;col 4; lines 35-55) upon the receipt of an order. Schell does not teach the triggering of an electronic funds transfer(EFT) authorization upon the purchase of a product. Schell does teach that even though its own system does handle credit card processing, the EDI function os Schell is "strong"

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and it is inferred that EFT would be possible(page 147;col 2;lines 45-50).Cahn teaches that in business systems implementing EDI, the use of EFT to transfer funds to a seller's account or financial institutions based on the buyer's authorization is old and well known. The advantages are increased cash flow, a reduction in float time, and an enhanced business relationship between customers and suppliers. The employment of an EFT system in Schell as claimed is obvious in view of Cahn for the advantages cited above.

Schell does not generate an electronic title(invoice) as claimed. Schell does teach the creation of an invoice(page 148;col 4). Applicant in his specification(page 27 lines 10-11) has equated invoice with title.Since the Specification equates title with electronic invoice, inherent in this, applicant's limitation, "including at least ...a commercial invoice" is met. Cahn teaches using EDI to generate electronic invoices(electronic title)(Abstract, page 1; page 2). Cahn teaches the advantage of using electronic invoices to implement electronic title(electronic invoices) to include streamlining the effort involved in the tracking processes. The use of an electronic invoice has been endorsed by the US Custom Service(Cahn, page 2) since it reduces the amount of time required for a shipment to clear through the customs process. The generation of an electronic invoice(electronic title) per Schell in view of Cahn for the benefits described here is obvious. Therefore the electronic invoice would be the electronic title and would define ownership. In view of the Customs Service endorsement, this method facilitates payment of taxes and duties as claimed.The process described by Schell and Cahn is implemented by EDI. EDI is an inter-company computer-to-computer communications system. This is used to implement business

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transactions in a standard format. Claim 1 cites that the business steps are implemented on the Internet. The EDI systems described in Schell and Cahn are dated 1991 and 1992, respectively. Similar to EDI, the Internet is a collection of computers that are linked. It is the position of the examiner, that to take a series of business steps implemented by EDI and perform these identical business steps employing the Internet would be an obvious use of current technology.

Specifically delineating the points in the Applicant's amendment, with respect to Claim 1(a) Schell teaches determining a language(col 4 lines 35-36) in which to view catalogue information on products. In reference to Claim 1(b) Schell teaches determining a currency(page 148 col 2 lines 15-20)(page 148 col 4 lines 25-35). In Claim 1(c), the system of Schell selects products to be purchased and a destination for said products thereby triggering a calculation for all costs(bill to/ship to)(cols 3 and 4 of page 148). With respect to Claim 1(d) Schell also teaches accessing at least one or more databases for at least one of the following items:(i) price(page 148 col 3 lines 14-23),(ii) product codes,(iii) shipping information(page 148 col 3 lines 29-33) related to an origination point of said selected product and said destination. Additionally, Schell teaches according to Claim 1(e) calculating costs involved in moving said selected product to said destination based upon said destination and said product(page 148 col 3 lines 20-22)(page 148 col 3 lines 30-31). Concerning Claim 1(f), Schell teaches ordering products(col 4 lines 49-57, page 147), as well as the creation of an invoice(page 4/col 4 lines 35-55). Finally, Claim 1(g), utilizing Schell in view of Cahn, Schell teaches that electronic funds transfer is possible(page 147 col 2 lines 45-50). Moreover, in Schell modified by Cahn, when a purchaser orders a product and an

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electronic funds transfer is activated, inherently a confirmation of funds is accomplished or implied. This is a necessary part of the transaction. Once it is determined that the funds are present, and then transferred title is passed and the product is shipped to its destination and owner.

Cahn teaches that in business systems implementing EDI, the use of EFT to transfer funds to a seller's account or financial institution based on the buyer's authorization is old and well known (page 2 lines 1-5). Additionally EDI as addressed by Cahn is as an alternative to paper based transactions (page 3 paragraph 5). It would have been obvious to one skilled in the art at the time of the invention to combine Schell in view of Cahn to teach the applicant's amended claim 1(g). The motivation is increased cash flow, reduction in float costs, and enhanced business relationships between suppliers and customers. Furthermore, Cahn teaches the advantage of using electronic invoices to implement electronic title (electronic invoices) as well as teaching using EDI to generate electronic invoices (Abstract, page 1; page 2). The generation of an electronic invoice (electronic title) combining Schell in view of Cahn for the benefits discussed here are obvious. With regard to the limitation "wherein said electronic title includes at least the data content of a commercial invoice" that appears in paragraph (g) of claim 1, since electronic title and commercial invoice are considered equivalent in light of applicant's specification, it is inherent that the data content of a commercial invoice would be included in the electronic title.

It appears that applicant argues that title is transferred upon the coinfirmation of the availability of funds, yet for the title to transfer, the funds need not be released. The scope of the

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language employed in Claim 1 is not limited to transfer of title upon solely the confirmation of the availability of funds.

12. With regard to amended claims 2-12 the various operational methods described in these claims as arranging for shipment of products selected by a customer along a chosen shipping route, calculation of the relevant taxes and import and export duties associated shipping costs linked with the selected route, and the execution of these transactions are all well known business practices. So they are considered obvious.

13. With regard to claim 13, Schell discloses a software program(Business 400) for handling order entry, order processing,inventory managment,accounting and reporting functions, all of which one of ordinary skill in theart would recognize as requiring access to a database and passing related information. Furthermore, in view of the complete set of import/export processing routines available in Business 400, one of ordinary skill in the art would have found it obvious that the import/export data could be routed electronically to the various points. Concerning Claim 13(a) Schell teaches computer to computer operation over the Internet for accessing one or more databases for at least one transaction. Schell teaches the transactions of price(col 3 lines 14-23, page 148) and shipping information(page 148, col 3 lines 29-33).With respect to Claim 13(b), Schell teaches a means for confirming available funds for a transaction (page 148 col 3 lines 17-19).In respect to Claim 13(c), Schell teaches that electronic funds transfer is possible(page 147 col 2 lines 45-50). Cahn teaches that in business systems implementing EDI, the use of EFT to transfer funds to a seller's account or financial institution based on the buyer's authorization is old

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and well known (page 2 lines 1-5). Additionally EDI as addressed by Cahn is as an alternative to paper based transactions (page 3 paragraph 5). It would have been obvious to one skilled in the art at the time of the invention to combine Schell in view of Cahn to teach the applicant's amended claim 13(c). With regard to the limitation "wherein said electronic title includes at least the data content of a commercial invoice" that appears in paragraph (c) of claim 13, since electronic title and commercial invoice are considered equivalent in light of applicant's specification, it is inherent that the data content of a commercial invoice would be included in electronic title. The motivation is increased cash flow, reduction in float costs, and enhanced business relationships between suppliers and customers. Furthermore, Cahn teaches the advantage of using electronic invoices to implement electronic title (electronic invoices) as well as teaching using EDI to generate electronic invoices (Abstract, page 1, page 2). The generation of an electronic invoice (electronic title) combining Schell in view of Cahn for the benefits discussed here are obvious. Finally, in regard to Claim 13(d) Cahn teaches that information from a shipping originator must include an invoice number and date, as well as shipment origin and destination (page 2 paragraph 8). Sending an invoice to a purchaser implicitly routes the invoice as the invoice travels with the goods and thus follows the same trajectory as the goods.

It appears that applicant argues that title is transferred upon the coinfirmation of the availability of funds, yet for the title to transfer, the funds need not be released. The scope of the language employed in Claim 1 is not limited to transfer of title upon solely the confirmation of the availability of funds.

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14. With respect to claims 14-17, the business methods discussed in these claims are considered obvious and are well-known. Thus there is no novelty or nonobviousness implied in these claims.

Response to Arguments

15. With respect to the Pool affidavit of 4/18/01, Pool states in paragraph 12 of that document that "in the area of international trade, ownership is not necessarily equated with a single international trade document." Thus ownership in some cases can indeed be equated with a single document. Pool concludes that, since ownership is not necessarily equated with a single international trade document, the electronic title is not limited to the commercial invoice. Thus if ownership in some cases is equated with a single international trade document, then it appears that the electronic title and commercial invoice are equivalents. Applicant on Page 27, lines 10-11 of the Specification clearly states that "electronic title(step 165) also referred to as commercial invoice." It appears that a reading of the specification, as originally filed, directs one of ordinary skill in the art in practicing applicant's invention to treat electronic title and commercial invoice as equivalents and not as Mr. Pool suggests-i.e. commercial invoice being a subset of electronic title.

With respect to the Blasdel affidavit of 4/18/01, Dr. Blasdel in paragraph 4 of this document states that "Schell's references to multiple currencies does not suggest the determination of a currency in which to obtain the price of a product in a catalogue, as recited in Claim 1 of the present application." One of ordinary skill in the art when reading Schell would note that Schell

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provides a system that facilitates translation of an international transaction which facilitates translation of "screens and reports to the user's language" (Schell/page 147(col 4 lines 15-40)). Furthermore, note Schell, page 148(col 4 lines 20-55). This portion of this reference addresses issue of payment. One of ordinary skill in the art would find it obvious to convert currencies to price a product to facilitate a user's application.

Dr. Blasdel further states in paragraph 5 of his affidavit that the Schell reference teaches a software protocol and that data is being imported and not goods. Inherently, Schell provides a mechanism for initiating or executing a transaction where goods are exchanged(sold) for money. With regard to paragraph 6 of Dr. Blasdel's affidavit, he states that the software product of Schell may support EDI, but does not imply that this product has any utility in processing international transactions. Dr. Blasdel also states that "Schell's allusion does not imply a relationship to UN/EDIFACT, the primitive standard for electronic messaging in an international trade transaction." Dr. Blasdel offers no substantive reasoning or proof to support these conclusions. Dr. Blasdel states that Schell provides no disclosure for the real time processing of international trade transactions. Since the claims are silent with respect to real time processing, any argument with respect to such processing is of no effect. With respect to paragraph 7 of Dr. Blasdel's affidavit, he states that Cahn's electronic invoice is limited to domestic applications. Cahn, on page 2 of his report, states that the US Customs Service endorses his system. Since the US Customs Service endorses this system, it would indeed appear that the transactions as addressed in his reference are international in nature. Furthermore, in paragraph 8 of Dr. Blasdel's

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affadavit he states that Cahn's use of the phrase "using EDI to generate electronic invoices" is inaccurate. The definition of EDI, however, includes the production of a document. Cahn teaches the generation of a document. Even if EDI does not make a document directly, EDI generates the data that Cahn uses to produce an electronic invoice.

With respect to the affadavit of Mr. Files dated 4/18/01, he comes to the same conclusion in paragraphs 8 and 9 of his affadavit as those set forth by Dr. Blasdel. The examiner's remarks in treating Dr. Blasdel's assertions are equally applicable to those of Mr. Files and are reiterated in the rejection.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



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